

## REMARKS

Claims 1-82 are in the application.

The claims have been carefully reviewed for consistency, to correct technical defects, and proper antecedent basis.

Claims 1-82 are rejected under 35 U.S.C. § 102(b) as being anticipated by “Online Privacy”; Red Rock Eater Digest (02/08/03) reporting an article “Clickshare(sm) alpha up; ‘test drives’ available” (10/24/95). As known to the Examiner, this references applicants own work, and therefore the rejection is based on a “public use or sale” in this country.

Claims 35-80 are rejected under 35 U.S.C. § 102(e) as being copied from Teper et al., US 5,815,665, allegedly without a prima facie assertion of priority of invention.

Claims 1, 3-7, 11-18, 20-24, and 28-34 are rejected under 35 U.S.C. § 103 as being obvious in view of Teper et al., US 5,815,665 alone.

Claims 2 and 19 are rejected as being obvious under 35 U.S.C. § 103 over Teper et al. in view of Reeder, US 5,852,812 and Ruehl, US 5,852,812.

Claims 8-10 and 25-27 are rejected as being obvious under 35 U.S.C. § 103 over Teper et al. in view of Payne et al., US 5,715,314 and Willens et al., US 5,889,958.

With respect to the consistency of these rejections in view of Teper et al., it is noted that the Examiner takes the position that Applicants’ own public use anticipates the copied claims of Teper et al. In order for the October 24, 1995 reference to qualify as anticipatory prior art, it must demonstrate all elements of the claims and further enable one of ordinary skill in the art to make and practice the invention. By applicants’ own admission in the reference, “Transaction-handling capabilities, and an initial base of

Publishing members, will be launched in early 1996.” Therefore, there is simply no evidence of any public use or offer for sale relating to transaction handling capabilities, which are an intrinsic part of the claims, but not part of the alpha test which was the subject of the October 1995 news release. Therefore, reconsideration of this rejection is respectfully solicited.

It is more particularly noted that the October 24, 1995 disclosure, and accompanying “use” were somewhat incomplete as compared to the final version. That disclosure specifically states:

Newshare Corp. begins shipping to selected publishers this week the alpha version of its breakthrough Clickshare(SM) system to track and settle Internet-wide micro-transactions.

"Clickshare removes one of the biggest barriers to the evolution of the Internet by giving users universal-ID access to a free market for digital information," said Bill Densmore, Newshare president and cofounder. "Yet the information -- and the user relationship -- remain physically controlled by the publisher."

**Clickshare's personal Newshare(sm) topic-profiling and custom-linking facilities are open for public use at <<http://www.clickshare.com/tryit.html>>. Transaction-handling capabilities, and an initial base of Publishing Members, will be launched in early 1996.**

"**At that point**, publishers will be able to sell each others' information for as little as a dime per click, exchanging royalties and commissions seamlessly," added Densmore. "Internet Service Providers will be able to act as on ramps into this content universe as well."

Clickshare requires no special software for consumers beyond their Web browser and costs a publisher as little as \$795 to join. Publishers can sell information by subscription or per-query to their own users, and set all pricing. **Newshare is now soliciting a broader group of "beta" publishers.**

Thus, this publication makes clear that the system as contemplated by the claims was **NOT** then available for public sale or use, since elements (c) and (d) of claim 1 and 18, were not available in the test, and further that the system and method were available

for alpha test (without fee, and thus without an accompanying "sale" or "offer for sale"). That is, the test was not intended for commercial purposes. This was, in fact, an experimental use to determine whether substantial elements of the invention were suitable and acceptable for their intended use. It is clear that, while Assignee projected prospective pricing, the activities in October, 1995, were not themselves commercial. No sale could have been made, since what was available was provided *for free*. Note also that elements of the October 1995 test were retained internal to Newshare Corp., and were not made available at all to the public, and there was never any offer nor intention to make these public in conjunction with the test.

MPEP 2133.03(e) Permitted Activity; Experimental Use, provides:

The question posed by the experimental use doctrine is "whether the primary purpose of the inventor at the time of the sale, as determined from an objective evaluation of the facts surrounding the transaction, was to conduct experimentation." *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1354, 63 USPQ2d 1769, 1780 (Fed. Cir. 2002), quoting *EZ Dock v. Schafer Sys., Inc.*, 276 F.3d 1347, 1356-57, 61 USPQ2d 1289, 1295-96 (Fed. Cir. 2002) (Linn, J., concurring). Experimentation must be the primary purpose and any commercial exploitation must be incidental. >Moreover, the experimental activity must have a nexus with the claimed invention. In other words, testing must be performed to "perfect claimed features, or features inherent to the claimed invention." *SmithKline Beecham Corp. v. Apotex Corp.*, \_\_\_ F.3d \_\_\_, 2004 WL 868425 (Fed. Cir. April 24, 2004) (holding that clinical trials to gain FDA approval were not "experimental use" because the claimed invention was a chemical compound that was reduced to practice when synthesized; the FDA trials had no relationship to the claimed invention because the testing was directed to the compound's unclaimed intended use).<

If the use or sale was experimental, there is no bar under 35 U.S.C. 102(b). "A use or sale is experimental for purposes of section 102(b) if it represents a bona fide effort to perfect the invention or to ascertain whether it will answer its intended purpose.. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of the experimentation to perfect the invention." *LaBounty Mfg. v. United States Int'l Trade Comm'n*, 958 F.2d 1066, 1071, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992) (quoting *Pennwalt Corp. v. Akzona Inc.*, 740

F.2d 1573, 1581, 222 USPQ 833, 838 (Fed. Cir. 1984)). "The experimental use exception. does not include market testing where the inventor is attempting to gauge consumer demand for his claimed invention. The purpose of such activities is commercial exploitation and not experimentation." In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983).

It is therefore respectfully submitted that, even were the October 1995 test to have publicly used the entirety of the invention, that any such use was experimental.

Claims 1-80 have been amended to provide a distinct registration service and broker/settler service. That is, the functions of registering and authenticating a user are separated from the functions of accounting for usage of services. In addition, various claims provide for a plurality of registration and/or brokering/settling databases. Each of these distinguishes both the Teper reference and the various press releases and/or the alpha or beta tests themselves.

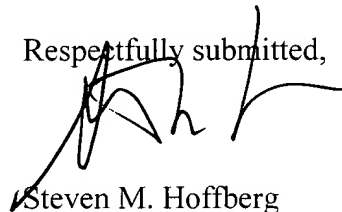
It is noted that applicants believe that the amendments have now obviated the need for declaration of interference. Applicants reserve the right to seek interference in a continuation application at a later date.

Claims 81 and 82 are rejected as being anticipated under 35 U.S.C. § 102(e) by Ferguson et al. The Examiner focuses on the abstract, Fig. 1 and Col. 9, lines 10-20 to support this rejection. Ferguson et al. do not disclose a separate user registration database, settlement server, and user account database, in accordance with the claim 81, in particular having a provider interface in which transactions may be posted without requiring a respective user identity. Note that at least element (b) of claim 82 ("... without requiring knowledge of a respective user identity by a posting party") is absent from Ferguson et al. Note that, in order to debit a user's account, the identity of the

account holder must first be established. If the service is provided anonymously, then there must be some intermediary to resolve any ambiguity to associate the respective account with the user. Withdrawal of the rejection of claims 81 and 82 is respectfully requested.

The other independent claims do not all expressly require anonymity; however, they do require 4 parties--the user, the service provider, the registrar, and the broker/settler, which are not taught or suggested by Ferguson et al. or Teper et al., and are therefore believed to be distinguished.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Hoffberg', is written over the text 'Respectfully submitted,'.

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